Accordingly, it is requested that the indicated provisional rejection of Claims 31, 32, and 37 be withdrawn.

The Office Action further rejects:

(a) Claims 20-22, 33, 43, and 44 under 35 U.S.C. § 103 as being unpatentable over Takahashi (U.S. Patent 5,067,029)(hereinafter "Takahashi") in view of Sasaki et al. (U.S. patent 5,034,804)(hereinafter "Sasaki");

(b) Claims 40-42 and 45 under 35 U.S.C. § 103 as being unpatentable over Takahashi in view of Sasaki and in further view of Kinoshita et al. (U.S. patent 4,897,732)(hereinafter "Kinoshita");

(c) Claim 34 under 35 U.S.C. § 103 as being unpatentable over Takahashi in view of Sasaki and in further view of Finelli (U.S. Patent 4,937,676)(hereinafter "Finelli");

(d) Claim 46 under 35 U.S.C. § 103 as being unpatentable over Takahashi in view of Sasaki and Kinoshita and in further view of Orii (U.S. Patent 5,200,663)(hereinafter "Orii");

(e) Claims 31 and 37 under 35 U.S.C. § 103 as being unpatentable over Lang (U.S. Patent 4,963,995)(hereinafter "Lang") in view of Sasaki; and

(f) Claim 32 under 35 U.S.C. § 103 as being unpatentable over Lang in view of Sasaki and in further view of Watanabe (U.S. Patent 5,032,927)(hereinafter "Watanabe").

Applicants respectfully traverse each of the above rejections.

In regard to Claims 20 and 43, the recited inventions are respectively directed to a camera which provides, generally, the ability to selectively transfer image information from an imaging device to a first memory or a second memory for storage. Each claimed invention includes a changer that selects a first memory or a second memory for storage *based on a condition of one of the two memories.*

For each claim, it was argued that the claimed inventions were obvious in view of the combined teachings of Takahashi and Sasaki. Takahashi teaches of a camera apparatus having a plurality of differing memories which are provided in a camera housing. The memory types include optical recording unit (30), semiconductor memory (40), magnetic recording unit (50). A selector (24) enables selection of memories (30), (40), and (50). The selector (24) is user-operated (column 7, lines 41-43) or controlled as a function of inputted image data (column 7, lines 45 and 46). *Takahashi is silent with regard to the selector (24) operatively selecting a memory based on a detected condition of one of a first memory or a second memory.*

The Office Action provides that Takahashi discloses a "changing means," such changing means being identified in the Office Action as an operation display (22) and a signal line (128). The Office Action further asserts that controller (20) "detects the condition of the memories." (Office Action, page 5). It is submitted, however, that the excerpts cited by the Office Action, in support of the interpreted

functionality of the controller (20) and the "changing means", concern only displaying information to a user regarding a prior memory selection by the user (column 4, lines 2-4) using operation display (22) or facilitating a memory change as instructed by the user (column 5, lines 53-55). In other words, Takahashi fails to teach of a detector and a changing means, adapted to work in concert, to change from one memory to another memory based on a detected condition of at least one of such memories for purposes of identifying a data storage location.

The Sasaki reference discloses camera (10) which stores image information on card memory (15). The Examiner cites Sasaki as teaching a camera using a semiconductor memory. Appropriately, it is not asserted that Sasaki teaches a detector and a changing means in accordance with the claimed invention, as Sasaki does not include such teachings. Thus, it is respectfully submitted that even if the teachings of Sasaki properly modified the teachings of Takahashi, such modified/combined teachings do not render obvious the claimed invention of Claim 20 nor Claim 43 as not all of the claimed limitations these claims are satisfied. Of course, all "claim limitations must be taught or suggested by the prior art. (citations omitted)" MPEP 2143.03 (7th ed., 1998).

The above discussion is equally applied to each of the claims that respectively depend from Claims 20 and 43. However, specific rejections of Claims 34 and 46 will be further addressed below.

Claim 34 is dependent upon Claim 20. In response to the additional limitations of Claim 34, the Examiner further cites the Finelli reference for combination with the above teachings of Takahashi and Sasaki. In particular, Finelli is said to disclose a printing device.

Notwithstanding the teachings of Finelli relied upon and cited by the Examiner, the Finelli reference fails to overcome the deficiencies, detailed above, for the combination of Takahashi and Sasaki. Specifically, Finelli is also silent regarding a detector and a changing means, adapted to work in concert, to change from one memory to another memory based on a detected condition of one of such memories for purposes of identifying a location for data storage. Accordingly, it is respectfully submitted that the combination of Takahashi, Sasaki, and Finelli fails to disclose, teach or suggest the claimed invention. Further, Applicants respectfully submit one having ordinary skill in the art could not reasonably combine these references, whether as cited or with any other known reference, to derive the present invention nor render it obvious.

Claim 46 is indirectly dependent from Claim 43. To address the added limitations of Claim 46, the Office Action combines the earlier-discussed teachings of Takahashi and Sasaki with those of Orii. Specifically, Orii is said to contribute "incorporation [of] a reproduction device for displaying images within a camera body." (Office Action, page 9).

Of note, however, the teachings of Orii, whether limited to these specific teachings or otherwise, fails to overcome the noted deficiencies of the Takahashi and Sasaki combination. Thus, it is respectfully submitted that the combination of Takahashi, Sasaki, and Orii fails to disclose, teach or suggest the claimed invention. Applicants further submit one having ordinary skill in the art could not reasonably combine these references, whether as cited or with any other known reference, to derive the present invention nor render it obvious.

In regard to Claim 40, the claimed invention requires, in part,

> . . .
> a recording device to store image information on one of the first memory and the second memory; a detector to detect an available memory capacity of one of the first semiconductor memory or the second semiconductor memory and to output a signal; and
> a first changer to selectively change between a first condition, in which image information outputted from said imaging device is stored on the first memory, and a second condition, in which image information outputted from said imaging device is stored on the second memory, based on an output signal from the detector;
> . . .

In general accordance with the discussion above, neither Takahashi nor Sasaki teach of a detector and a first changer, adapted to work in concert, to change from one memory to another memory based on a detected condition, for example, an available memory capacity, of one of such memories for purposes of selecting a data storage location.

The deficiencies of Takahashi and Sasaki in this regard are not cured by the teachings of Kinoshita. In furtherance of this position, it can be seen from Figures 1, 6, and 8 of Kinoshita that a selection between memories, based on a condition of the memories or otherwise, is not taught or even contemplated by the Kinoshita reference. Rather, for purposes of this example, Figure 1 illustrates that any image data stored on disc (20) must always pass through frame memory (7).

Accordingly, it is respectfully submitted that the combination of Takahashi, Sasaki, and Kinoshita fails to disclose, teach or suggest the claimed invention. Further, Applicants respectfully submit one having ordinary skill in the art could not reasonably combine these references, whether as cited or with any other known reference, to derive the present invention nor render it obvious.

In regard to Claim 31, the present invention is directed to an editing device which provides, generally, a first reception unit, which receives a removable memory card; a second reception unit, which receives a memory device; a signal processor to restore processed image information, stored on a removable memory card and received within the first reception unit, to original image information; and a recorder to record the original image information on the memory device. The Office Action finds that such device is rendered obvious by the combination of the teachings of Lang and Sasaki.

The Lang reference is directed to a device capable of transferring original data from a first removable storage medium (23_1) to a second removable storage medium (23_2); however, the reception unit (11) can only receive one storage medium (23_i) at a time. During a transfer of data, original data is taken from storage medium (23_1), compressed, and stored in memory (13). Subsequently, the compressed data of memory (13) is expanded and transferred to storage medium (23_2), which then occupies the space vacated by storage medium (23_1).

Applicants respectfully submit that the Lang reference fails to disclose an original, removable storage medium (e.g., storage medium (23_1)) that stores processed image data that requires restoration. Consequently, the structure of the Lang system which receives stored image data is fundamentally different from that claimed by the Applicants. Specifically, Lang fails to disclose, teach, or suggest:

> . .
> a signal processor to restore processed image information, stored on a removable memory card received by the first reception unit, to original image information obtained in a photographing operation;
> . . .

While it is acknowledged that Lang teaches of a signal processor to decompress image data stored in memory (13), such is necessary due to the operation of the Lang device, which *receives uncompressed image data* and *outputs uncompressed image data* but, in an intermediate

storage step, elects to compress the received image data for intermediate storage.

Appropriate to this attempted redesign of the Lang device,

> [if] the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. (citations omitted)

MPEP 2143.01 (7th ed., 1998).

Moreover, the additional cited reference--Sasaki--does not aid in overcoming these fundamental deficiencies of Lang.

The Examiner relies on Sasaki for the generalized teachings of removable memory cards. However, as provided above, even if the fixed memory (13) of Lang were interchangeable with a conventional memory card (for example, memory card (15) of Sasaki), neither Lang nor Sasaki provide for at least a signal processor in accordance with the claimed invention.

Lang, alone or in combination with Sasaki, does not disclose, teach or suggest the claimed invention. Further, Applicants respectfully submit one having ordinary skill in the art could not reasonably combine these references, whether as cited or with any other known reference, to derive the present invention nor render it obvious. The above discussion is applied to Claims 32 and 37, as dependent claims of Claim 31.

In further reference to Claim 32, the Examiner further cited Watanabe as providing teachings of data decompression based on a particular manner, i.e., DCT. Incorporating the above discussion of the shortcomings of the Lang and Sasaki combination, it is further submitted that the addition of Watanabe, even if given its broadest interpretation, does not enable a finding that the claimed inventions of Claim 32, or even Claim 31, is rendered obvious by these references given the fundamental differences between the claimed inventions and the cited references' combined teachings.

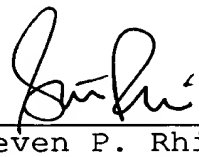
Applicants respectfully submit Claims 20-22, 31-34, 37, and 40-46 are patentably distinct over the cited references and this application is considered to be in condition for allowance. Applicants respectfully request Examiner's reconsideration of this matter in light of this Amendment and withdrawal of all provisional and Section 103 rejections.

This Amendment does not result in an increase in either the number of independent claims or the total number of claims, and does not present any multiple dependency claim. Accordingly, no fee based on the number or type of claims is incurred by this Amendment. However, if a fee were to be required, please charge any fee (other than an issue fee) required during the pendency of this U.S. patent application to Deposit Account 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate

Request for Extension of Time filed herewith, this document is to be construed as also constituting a Request for Extension of Time under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such Request for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to deposit account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,



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